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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,632	01/23/2004	James R. Lawler	ORAS002USACNT1 (J&JO-103U)	7747
27777 7590 10/02/2008 PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003				
EXAMINER LEWIS, RALPH A				
ART UNIT		PAPER NUMBER		
3732				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/763,632

Applicant(s)

LAWTER ET AL.

Examiner

Ralph A. Lewis

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-27, 36-41 and 49-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22-27, 49 and 50 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

Rejections based on Prior Art

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 36-39, 51 and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by Egolf (US 4,909,788).

Egolf discloses an apparatus for dispensing material comprising a barrel 12 and tube portion 24. The tube portion 24 includes a tip 28 which is capable of being deformed to a different cross-section. A plunger 18 is slidably housed within barrel 12 and contacts external force applying members 22 and 44. The barrel includes flanges 36 which have radial flexibility (note column 3, lines 30-34) to allow for locking engagement with external force applying member 44. In regard to claim 37, one of the flanges 36 can be considered the nub and element 42 the indent; the arrangement allows for the barrel to remain stationary as set forth in the abstract.

Claims 36-41 and 49-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Stefaniak et al (US 5,004,124).

Stefaniak et al disclose an apparatus for dispensing comprised of a barrel 22 having a body portion and a tip portion 34. The tip portion is capable of being

deformed. A plunger 24/26 is slidably received within the barrel body portion 22. The body portion includes flexible flanges 54, 56 which allow for a snap fit with force applying member 30/32. In regard to claim 37, element 54 also acts as the claimed nub. In regard to claim 40, note sleeve 30, shaft 48 and spring 82/92. In regard to claim 41, springs 32 and/or 82 are capable of encircling one's thumb.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 36-41, 51 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefaniak et al (US 5,004,124) in view of Frush (US 5,244,388) and/or Egolf (US 4,909,788).

Stefaniak et al are silent as to the flexibility of tip 34. The examiner has taken the position above in the 102 rejection that any mechanical element can be "deformed". However, in the event that the "tip configured for being deformed" is deemed to require that the tip have a given amount of flexibility such that it is easily bent during use, then Frush is cited as teaching that it is desirable to make such dental application tips flexibly deformable so that dental material may be more easily spread over the teeth surfaces. To have made the Figure 2 tip 34 of Stefaniak et al flexibly deformable so that the dental material may be more easily and evenly distributed over the teeth as taught by

Frush would have been obvious to one of ordinary skill in the art. In regard to the flexible flanges limitation, to the limited extent that it is deemed that elements 56 and 54 of Stefaniak et al do not meet the "flexible flanges" limitation, then one of ordinary skill in the art would have found it obvious to have formed notches in the flange member 54 in view of the notch 38 (column 3, lines 30-34) teaching by Egolf for a similar syringe type coupling in order to provide for more radial flexibility to engage the receiving notch.

Response to Applicant's Remarks

The examiner is in general agreement with applicant regarding the impropriety of the rejection based on Brizzolara et al, Kozam and Firth et al. Particularly troubling is the reversing of parts in Firth et al and then applying that reversed teaching to the distantly related Brizzolara et al reference. Accordingly, this rejection has been withdrawn.

Allowable Subject Matter

Claims 22-27 49 and 50 are allowed.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

This application has been transferred as Examiner Bumgarner has accepted another position within the Office. Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number **(571) 272-4712**. Fax (571) 273-8300. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Cris Rodriguez, can be reached at (571) 272-4964.

R.Lewis
September 28, 2008

/Ralph A. Lewis/

Primary Examiner, Art Unit 3732